

Application No. 10/002,799
Reply to Office Action of May 15, 2007

REMARKS

Claims 21 – 40 and 50 – 56 are currently pending in the Application. Claims 21, 26, 31 and 36 have been amended. New claims 50 – 56 have been added. Claims 1 – 20 were cancelled in a previous Amendment, and claims 41 – 49 have been cancelled in the present amendment.

Support for the amendments to claims 21, 26, 31 and 36 as well as new claims 50 – 56 may be found, for example, in the specification at paragraphs [0026] and [0027]. Accordingly, no new matter has been added to the application by the foregoing amendments.

Double Patenting

The Examiner has rejected claims 21 – 49 under the judicially created doctrine of double patenting as being unpatentable over claims 1 – 20 of U.S. Patent No. 7,072,683 (“the ‘683 patent”). The Examiner contends that the subject matter claimed in the present application is not patentably distinct from that claimed in the ‘683 patent.

Applicants have submitted herewith a Terminal Disclaimer under 37 C.F.R. §1.321(b), stating that the ‘683 patent and the present application are all commonly owned and disclaiming the terminal part of the statutory term of any patent granted on the present application which would extend beyond the full statutory term of the ‘683 patent. A statement under 37 C.F.R. 3.73(b), showing chain of title of the present application, is also enclosed herewith.

The Examiner has provisionally rejected claims 21 – 49 under the judicially created doctrine of double patenting as being unpatentable over claims 1 – 20 of U.S. Patent Application No. 10/307,096 and claims 1 – 25 of U.S. Patent Application No. 10/307,175. The Examiner contends that the subject matter claimed in the present application is not patentably distinct from that claimed in these applications.

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Applicants respectfully submit that Application No. 10/307,096 went abandoned on April 17, 2006, and Application No. 10/307,175 went abandoned on August 30, 2006. Since these applications are no longer pending, the Examiner's provisional double patent rejections of the currently pending claims in the present application are moot.

Reconsideration and withdrawal of the Examiner's non-statutory double patenting rejections are respectfully requested.

Claim Rejection – § 112, Second Paragraph

Claims 21 – 49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 21, 26, 31 and 36 have been amended to recite, “A method of accessing a picture file received from a cellular telephone,” such that the preamble is consistent with the subject matter recited in the body of the claims. Accordingly, claims 21, 26, 31 and 36, and all claims dependent thereon, are believed to be definite. Claims 41 – 49 have been cancelled. Reconsideration and withdrawal of the Examiner's § 112, second paragraph, rejection are respectfully requested.

Claim Rejections – § 103(a)

Claims 21-22, 24-27 and 29-49 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent No. 6,724,403 to Santoro et al. (hereinafter Santoro) in view of Heather McDaniel, PalmPower Review, Album to Go software (hereinafter McDaniel), and further in view of U.S. Patent No. 6,970,859 to Breachner et al. (hereinafter Breachner). Applicants respectfully traverse this rejection.

1) The Proposed Combination Does Not Teach or Suggest All Claimed Elements

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Even if Santoro, McDaniel and Breachner are properly combinable, such a combination would not teach each all of the elements of the Applicant's claims.

Claim 21 recites:

A method of accessing a picture file received from a cellular telephone, said method comprising the steps of:

receiving said picture file at said cellular telephone;

simultaneously displaying a plurality of picture files on a display of said cellular telephone;

enabling a first user to change information displayed with said received picture file by way of a user interface on said cellular telephone;

providing a separate selection option for each picture file of said plurality of picture files when said plurality of picture files is displayed on said cellular telephone;

enabling the first user to separately select a selection option for each picture file of said plurality of picture files;

displaying a subset of said plurality of picture files on said display according to a selected display function, said subset comprising picture files selected by way of said selection options associated with said plurality of picture files;

enabling access by said first user, remote from said cellular telephone by way of a webpage associated with a wireless service provider for said cellular telephone, to said plurality of picture files and said information which has been changed; and

enabling a second user to separately select a selection option associated with each picture file of said plurality of picture files displayed on said webpage by way of said webpage.

Santoro in view of McDaniel and Breachner does not teach or suggest each and every element of independent claim 21. Most notably the combination of the references

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does not teach "enabling access by said first user, remote from said cellular telephone by way of a webpage associated with a wireless service provider for said cellular telephone, to said plurality of picture files and said information which has been changed." The Examiner argues that this feature is taught in Santoro at column 23, lines 1 – 18; column 23, lines 60 – 67; Fig. 4 and column 9, lines 1 – 56. The Examiner's contention is that having a picture file stored on a world-wide web page teaches this claim element (see Non-Final Rejection, May 15, 2007, page 8). Applicant respectfully disagrees.

Santoro "provides an easy to use graphical interface that facilitates the organization and management of multiple data sources corresponding to a user's needs and interests" (Santoro, column 4, lines 34 – 37). The Examiner argues that column 23, lines 1 – 18 teach "enabling access by [a] user, remote from [a] cellular telephone by way of a webpage associated with a wireless service provider for said cellular telephone, to said plurality of picture files and said information which has been changed." However, this portion of Santoro states (in part) that, "a user's custom grid may contain a tile that points to a third party web-site 2604. Content 2606 from the 3rd party web-site is typically transferred to the server for dissemination to the user." Thus, Santoro teaches that information from a third party web-site is sent to user device 2600. Stated differently, Santoro teaches a system of receiving information from the world-wide web on a device, as opposed to enabling information from the device to be accessed at a website as recited in claim 21.

Furthermore, Santoro does not teach or suggest a webpage associated with a wireless service provider. The Examiner has incorrectly assumed that "a picture file stored on the World Wide Web" (Non-Final Rejection, May 15, 2007, page 8) is the same as "enabling access by [a] user, remote from [a] cellular telephone by way of a webpage for a user associated with a wireless server provider for said cellular telephone" (claim 21). A picture file stored on the World Wide Web (as described in Santoro and relied-on by the Examiner) is not the same or even similar to "enabling access by [a] user, remote from [a] cellular telephone by way of a webpage for a user associated with a wireless server provider for said cellular telephone."

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McDaniel is a review of a Palm product which allowed users to share pictures using the Palm operating system. The Examiner argues that "McDaniel explicitly discloses a software or an application that provides a separate selection option for each picture file of said plurality of picture files when said plurality of picture files is displayed on said cellular telephone ..." (Non-Final Rejection, May 15, 2007, page 8 to page 9). However, the primary problem with the Examiner's assertion is that McDaniel never discloses a plurality of picture files being displayed at the same time. Claim 21 recites **"simultaneously displaying plurality of picture files" and "providing a separate selection option for each picture file of said plurality of picture files when said plurality of picture files is displayed on said cellular phone."** In claim 21 a separate selection option exists while a plurality of picture files are being displayed simultaneously. At no point in McDaniel are the picture files simultaneously displayed on the user device. A concurrent problem with the Examiner's assertion is that claim 21 recites providing a selection option of the picture files **"when said plurality of picture files"** are displayed. The Examiner argues that this element is taught in Figs. B and C of McDaniel (see Non-Final Rejection, May 15, 2007, page 9). However, it can plainly be seen in Figs. B and C that the options for a picture file are not selected when the picture files are displayed. As such, the Examiner has mischaracterized McDaniel's teachings.

Additionally, McDaniel does not teach or suggest the use of a cellular telephone as recited in the claims. The software reviewed in McDaniel refers specifically to the "Palm II, Palm IIIe, Palm IIIx, Palm V and Palm VII" (McDaniel, page 1). These Palm models were not cellular phones, nor did they have the capacity to make telephone calls, receive telephone calls or have any similar technology. Although in today's world it is common practice to have PDAs with cellular technology and a screen for viewing pictures built in, this was not the case with the Palm II, Palm IIIe, Palm IIIx, Palm V or Palm VII. McDaniel does not explicitly or implicitly suggest that the software could be used for or would be advantageous to be used on a cellular phone, since cellular phones simply did not have this capability. Therefore, McDaniel, which reviews software for a non-cellular PDA, does not teach software or an application that provides a separate

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selection option for each picture file of said plurality of picture files when said plurality of picture files is displayed on [a] cellular phone.

The Examiner has acknowledged that Santoro and Breachner do not teach “enabling access by [a] user, remote from [a] cellular telephone by way of a webpage for a user associated with a wireless server provider for said cellular telephone.” As discussed above, McDaniel clearly does not teach the claimed element. Accordingly, the combination of McDaniel, Santoro and Breachner does not teach or suggest all of the claimed elements of the Claim 21.

Independent claims 26 and 31 recite “providing a separate selection option for each picture file of said plurality of picture files displayed on said cellular phone.” Independent claim 36 recites “providing a plurality of selection options, each said selection option being associated with a picture file of said plurality of picture files.” Similarly, new claim 54 recites “enabling a user to edit information associated with at least one of plurality of picture files.” For the same reasons discussed above with respect to independent claim 21, these elements are not taught by the combination of McDaniel, Santoro and Breachner.

2) Motivation to Combine

Those of ordinary skill in the art would not look to McDaniel to modify Santoro to result in Applicants’ claimed invention. Santoro attempts to solve the problem that “display technologies currently lack an interface which is capable of organizing any type of information, presenting such information to the user in a consistent manner and in such a way that all currently open channels are able to indicate their activity on a continual basis” (Santoro, column 4, lines 24 – 29). This is accomplished through the use of “a grid of tiles that resides on the user’s computer desktop” (Santoro, column 4, lines 37 – 38). This grid of tiles is aimed at providing a user with many different types of, or instances of, information. McDaniel teaches a review of a slide show picture viewer for the Palm operating system. McDaniel does not seek to solve a similar problem as Santoro, and

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never discusses the use of more than one picture on a screen at the same time. One skilled in the art of improving information interfaces through the use of grids showing many different types of information, would not look to a slide show viewer (which only views pictures), such as McDaniel, on a proprietary operating system which does not allow for different types of information to be shown on screen. Therefore, the combination of Santoro and McDaniel is improper.

Moreover, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. See *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959); MPEP § 2143.01. The solution proposed in Santoro is to use a grid of tiles to organize data (see Figs. 1, 3, 4 5, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21 and 26 as well as claims 1 – 52). In Santoro's grid, several pictures or other instances of data are displayed on the screen at the same time. In McDaniel, data is managed through the use of a slide show, wherein one, and only one, picture is displayed on screen at any given time. Therefore, modifying Santoro with McDaniel would eliminate the use of a grid in favor of using a slide show to organize data rather, which is counter to the principle of operation of Santoro.

Accordingly, independent claims 21, 26, 31, 36 and 54 are believed to be allowable over the proposed combination of Santoro, McDaniel and Breachner. Dependant claims 22-25, 27-30, 32-35 and 37-40, 50 – 53 and 55 – 56 are believed to be allowable at least by their dependency on independent claims 21, 26, 31, 36 and 54, respectively.

Claims 23 and 28 are rejected as being unpatentable over Santoro in view of McDaniel, Breachner and further in view of U.S. Patent No. 6,360,252 to Rudy et al. (Rudy). For the reasons discussed above, independent claims 21 and 26 are believed to be allowable over the combination of Santoro, McDaniel and Breachner. Applicants respectfully submit that Rudy does not teach or suggest the elements missing from this combination. Accordingly, independent claims 21 and 26 are believed to be allowable over the proposed combination of Santoro, McDaniel, Breachner and Rudy. Dependent

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claims 23 and 28 are allowable at least by their dependency on independent claims 21 and 26, respectively.

Reconsideration and withdrawal of the Examiner's §103(a) rejections are respectfully requested.

Conclusion

In view of the forgoing amendments and remarks, Applicants respectfully submit that the Examiner's rejections have been overcome, and that the application, including claims 21 – 40 and 50 – 56, is in condition for allowance. Reconsideration and withdrawal of the Examiner's rejections and a Notice of Allowance are respectfully requested.

Respectfully submitted,

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